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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,683	01/18/2002	Roy J. Walker	1112431-0351	3749

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WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

KING, BRADLEY T

ART UNIT PAPER NUMBER

3683

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/052,683	Applicant(s) WALKER, ROY J.	
	Examiner Bradley T King	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 8, 9, 12, 13 and 17-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 3-5, 8, 9, 12, 13 and 17-21 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5, 8-9, 12-13 and 17-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-5, 8-9, 12-13 and 17-21 have been amended to include the transitional phrase "consisting essentially of". The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). See MPEP 2111.03. It is not clear from the original disclosure what elements are to be excluded. For instance, the specification discloses fasteners to attach the backing plate to the shoe. Claims 4 and 21 claim a brake pad assembly "consisting essentially of", but fail to claim fasteners. While it appears from applicant's arguments that the claim language is intended to preclude a second shoulder, it is noted that the original disclosure fails to provide any significance to the single shoulder. In fact, the disclosure states "A shoulder 14 (which may take many forms including the form of a tab as shown in the drawings) for carrying braking force shear loads protrudes normally away from the rail-facing surface 13." Therefore, from the disclosure there appears to be no

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criticality in the shoulder configuration or the number of shoulders. In light of this disclosure, it is maintained that the transitional phrase renders the scope of the claim indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 8-9, 12-13 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al (US# 5979615) in view of Chwastiak et al (US# 5693402).

Thompson et al discloses an elevator safety brake including; an elevator brake wedge 26 comprising: a top surface; a bottom surface, the bottom surface generally parallel with the top surface and located below the top surface; an inclined surface intersecting the top surface at an obtuse angle and intersecting the bottom surface at an acute angle; a rail-facing surface, intersecting the top and bottom surfaces at approximately a right angle; and a single shoulder; the single shoulder located near the top surface and extending normally away from the rail-facing surface, the shoulder for absorbing shear loads from an elevator brake pad; a brake pad backing plate, the brake pad backing plate having a pad-mounting surface for mounting a brake pad and a wedge-mounting surface for

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engaging the rail-facing surface of the elevator brake wedge, the brake pad backing plate mounted along the rail-facing surface of the elevator brake wedge below the shoulder; a brake pad for engaging a steel elevator guide rail comprising: a mounting backing surface for engaging the backing plate, and sliding surface for engaging an elevator guide rail. Thompson et al lack the specific friction material and a burnished finish. Thompson et al discloses the use of a carbon based material due to its consistent friction properties and further discloses the desirability of friction materials with high friction coefficients and consistent friction characteristics in elevator brake application. It is well known in the art to select friction compounds through routine calculation or experimentation to provide a brake element suitable for a given application. The instant specification indicates that carbon metallic friction materials are known in the art (page 3, lines 2-4 indicate the use of standard materials). It would have been obvious to one of ordinary skill in the art at the time the invention was made to select a carbon metallic material as part of routine material selection to provide consistent braking, thereby increasing the safety of the elevator brake.

Chwastiak et al teach a method of laser burnishing a brake pad to decrease the brake-in period of the pad so that the pad exhibits a more stable friction coefficient. It further would have been obvious to one of ordinary skill in the art at the time the invention was made to laser burnish the pads of Thompson et al as taught by Chwastiak et al to provide a more stable friction coefficient, thereby increasing the consistency and safety of the brake.

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Regarding claims 5 and 9, Thompson et al lack the disclosure of the claimed equation which describes the coefficient of friction. However, the equation appears to be a characterization of the coefficient of friction for the carbon metallic material. Selection of the same known material will inherently be described by the equation.

Double Patenting

Applicant is advised that should claims 12-13 be found allowable, claims 17-18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Response to Arguments

Applicant's arguments filed 6/18/2004 have been fully considered but they are not persuasive.

Please note the 112 2nd paragraph rejection above. It is maintained that the second shoulder of Thompson et al does not materially affect the basic and novel characteristic(s) of the claimed invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley T King whose telephone number is (703) 308-8346. The examiner can normally be reached on 11:00-7:30 M-F.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

BTK
August 29, 2004


DOUGLAS C. BUTLER
PRIMARY EXAMINER
AU 3683 8/30/04